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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/854,163

05/11/2001

May D. Eng

BEAS-01047US0

7139

23910 7590 04/27/2007  
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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT

PAPER NUMBER

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/854,163

**Applicant(s)**

ENG, MAY D.

**Examiner**

Mary Cheung

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 48-54,57,59-68,71,73-79,83-94 and 98-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 76-79,83-94 and 98-105 is/are allowed.
- 6) ☐ Claim(s) 48-54,57,59-68,71,73-75,106 and 107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/28/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the RCE filed on February 28, 2007. Claims 48-54, 57, 59-68, 71, 73-79, 83-94 and 98-107 are pending. Claims 48, 57, 62, 71, 76, 91 and 106 are amended. All the pending claims are examined.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 48-54, 57, 59-68, 71, 73-75 and 106-107 have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments filed February 28, 2007 have been fully considered but they are not persuasive.

The applicant argues that the Brandt (U. S. Patent 5,758,068) fails to teach the grace period is initiated when the total number of licensed software users exceeds to the maximum number of licenses, instead, Brandt teaches the grace period is initiated when the total number of licensed software users equals to the maximum number of licenses (column 2 lines 6-19 and column 7 lines 27-52 and Fig. 6). Examiner believes that the differences between the grace period is initiated when the total number of licensed software user exceeds and equal to the maximum number of licenses are not patentably distinct, and it would have been obvious to one of ordinary skill in the art to modify the specified license threshold condition based on the design need for better warning the user at desired time.

In response to applicant's argument that there is no suggestion to combine the teachings of Wyman and Brandt, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the

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claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Brandt teaches control the usage limits of the licensed software by setting up a grace period (column 7 lines 36-44), and Wyman (U. S. Patent 5,438,508) teaches control the usage limits of the licensed software by setting up a overdraft limits (column 39 lines 26-40). It is the knowledge generally available to one of ordinary skill in the art to setup a grace period for a user to renew the license when the usage is reached a predetermined threshold level.

The applicant argues that the Rivera (U. S. Patent 6,056,786) fail teach triggering of a warning message if the total number of licensed software users exceeds a limit that is less than the maximum number of licenses, instead, Rivera teaches a warning message is triggered the number of client computers exceeds the number of client licenses. Examiner believes that when the warning message to be sent is design choice not a patentably distinct feature. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the master node in the combined teaching of Wyman and Barritz to send a warning message if the total number of licensed software users exceeds a predetermined value for alerting the over-usage of the licenses, wherein the predetermined value is based on design needs.

In response to applicant's argument that there is no suggestion to combine the teachings of Wyman and Rivera, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the

Art Unit: 3694

claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is the knowledge generally available to one of ordinary skill in the art to send warning message when the usage of license is reached a predetermined threshold level.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 48-54, 59-68 and 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyman, U. S. Patent 5,438,508 in view of Brandt et al., U. S. Patent 5,758,068, and in further view of Barritz et al., U. S. Patent 6,029,145.

As to claims 48 and 62, Wyman teaches a computer network including a multi-tier licensing system, and a multi-tier licensing system method, comprising: (Fig. 1):

- a) A user tier including user computers (column 9 lines 54-56 and Fig. 1);
- b) A remote node tier (*delegatee servers 13 of Fig. 1*) including remote nodes enabling users to run a licensed software program, at least some remote nodes allowing multiple users at multiple computers to run the licensed software program concurrently, the remote nodes producing counts or indications of the numbers of licensed software users associated with the remote nodes (column 9

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line 30 – column 10 line 1 and column 10 lines 35-41 and column 11 lines 23-54 and column 15 line 48 and column 16 line 2 and column 20 lines 28-35 and Fig. 1);

c) A master node tier (*license server 10 of Fig. 1*) including a mater node receiving the counts from the remote nodes and calculating a total number of licensed software users, and the master node evaluating a license allocation condition using the total number of licensed software user, the master node initiates a license overdraft-limit if the total number of licensed software users equals a maximum number of licenses (column 9 line 30 – column 10 line 1 and column 11 lines 17-35 and column 12 line 65 – column 13 line 10 and column 15 lines 1-67 and column 39 lines 15-38 and Figs. 1-3).

Wyman does not specifically teach the overdraft-limit is a grace period.

However, Brandt teaches initiates a license lockout grace period if the total number of licensed software users equals a maximum number of licenses (column 2 lines 6-19 and column 7 lines 27-52 and Fig. 6). Although, Brandt does not specially teach initiates a license lockout grace period if the total number of licensed software users exceeds a maximum number of licenses, it would have been obvious to one of ordinary skill in the art to allow the grace period in Brandt's teaching to be initiated at a specified license threshold condition based on the design need (i.e. equal or exceed a threshold number) for warning the user's at a desired time. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Wyman's teaching to include the feature of initiates a license lockout grace period if the

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total number of licensed software users exceeds a maximum number of licenses as taught by the modified teaching of Brandt for better controlling the licensing right.

The combined teaching of Wyman and Brandt does not specifically teach the remote nodes periodically producing counts of the number of licensed software users associated with the remote nodes, and the master node periodically receiving the counts from the remote nodes. However, Barritz teaches remote nodes periodically counts licenses and send to the master node (column 3 lines 14-29 and column 12 lines 11-25 and column 13 lines 18-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the combined teaching of Wyman and Brandt to include the feature of periodically counts the licenses by the remote nodes and the master node periodically receives the counts as taught by Brandt for monitoring the usages of the licenses.

As to claims 49 and 63, Wyman teaches the remote nodes and master node run licensing software (column 9 line 30 – column 10 line 1 and Fig. 1).

As to claims 50 and 64, Wyman teaches the master node is selected as the master node from the nodes running the licensing software (column 9 lines 30-39).

As to claims 51 and 65, Wyman teaches the remote nodes server the licensed software to the users in the user tier (column 9 line 30 – column 10 line 11 and Fig. 1).

As to claims 52 and 66, Wyman teaches a sanity scan is done on at least one subset of the remote nodes (column 23 lines 38-50).

As to claim 53 and 67, a scan result message is sent to the master node with at least some of the counts is taught by Wyman as the master node (*license server 10 of Fig. 1*) authorizes the remote nodes (*delegatee server 13 of Fig. 1*) to administrate

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usages of licenses for user nodes (*users 16 of Fig. 1*), the remote nodes scan and calculate user's licenses, the remote nodes further maintain log files for each user node regarding the usages of the licenses, and the log files are also stored in the master node (column 9 line 30 – column 10 line 1 and column 10 lines 35-41 and column 11 lines 17-54 and column 12 line 65 – column 13 line 13 and column 23 line 38 – column 24 line 12 and Fig. 1).

As to claims 54 and 68, Wyman further teaches the master node check whether the scan result message has been received from all of the remote nodes and deallocates any licenses allocated to users of any of the nodes upon receiving termination messages, such as error status or abnormal termination, etc. (column 15 lines 38-40 and column 16 line 51 – column 17 line 2). Wyman does not specifically teach the received termination messages, such as error status or abnormal termination including message from which a scan result message has not been received. It would have been obvious to one of ordinary skill in the art allow the received terminal messages in Wyman's teaching to include message from which a scan result message has not been received for securely and efficiently utilizing licenses.

As to claims 59-60 and 73-74, the counts are sent to the master node asynchronously and periodically are taught by Wyman as transmitting said counts whenever the license usage occurs (column 10 lines 35-40 and Figs. 1-3).

As to claims 61 and 75, Wyman teaches computer network is a distributed computer network (column 6 lines 66-68).

6. Claims 57 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyman, U. S. Patent 5,438,508 in view of Brandt et al., U. S. Patent 5,758,068 and



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Barritz et al., U. S. Patent 6,029,145, and in further view of Rivera et al., U. S. Patent 6,056,786.

As to claims 57 and 71, Wyman modified by Brandt and Barritz teaches the master node compares the total number of licensed software users to a predetermined value as discussed above. Wyman does not specifically teach the master node sends a warning message if the total number of licensed software users exceeds a limit that is less than the maximum number of licenses. However, Rivera teaches the server node sends a warning message if the total number of licensed software users exceeds a predetermined value (column 8 lines 39-66). Rivera does not specifically teach that the predetermine value is a limit that is less than the maximum number of licenses. It would have been obvious to one of ordinary skill in the art to realize that to set the predetermined value to be less than the maximum number of licenses is a design choice; thus, one of ordinary skill in the art would have been motivated to set the predetermined value to be a number based on design need. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the master node in the teaching of Wyman modified by Brandt to send a warning message if the total number of licensed software users exceeds a predetermined value for alerting the over-usage of the licenses, wherein the predetermined value is based on design need.

7. Claims 106-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyman, U. S. Patent 5,438,508 in view of Barritz et al., U. S. Patent 6,029,145, and in further view of Rivera et al., U. S. Patent 6,056,786.

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As to claims 106-107, Wyman modified by Barritz teaches all the limitations as discussed above except for teaching the master node sends a warning message if the total number of licensed software users exceeds a limit that is less than the maximum number of licenses, and the limit is a predetermined percentage of the maximum number of licenses. However, Rivera teaches the server node sends a warning message if the total number of licensed software users exceeds a predetermined value (column 8 lines 39-66). Rivera does not specifically teach that the predetermine value is a limit that is less than the maximum number of licenses, and the limit is a predetermined percentage of the maximum number of licenses. It would have been obvious to one of ordinary skill in the art to realize that to set the predetermined value to be less than the maximum number of licenses, and the limit is a predetermined percentage of the maximum number of licenses are design choices; thus, one of ordinary skill in the art would have been motivated to set the predetermined value to be a number based on design needs. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the master node in the combined teaching of Wyman and Barritz to send a warning message if the total number of licensed software users exceeds a predetermined value for alerting the over-usage of the licenses, wherein the predetermined value is based on design needs.

***Allowable Subject Matter***

8. Claims 76-79, 83-94 and 98-105 are allowed.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-

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6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300	(Official Communications; including After Final Communications labeled "BOX AF")
(571) 273-6705	(Draft Communications)

Mary Cheung  
April 25, 2007



**MARY D. CHEUNG  
PRIMARY EXAMINER**